



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,536	01/12/2001	Carl Teo Balbach	31215.new	1174

7590 01/21/2004

R. Kent Roberts  
Hodgson, Russ, Andrews,  
Woods & Goodyear LLP  
One M&T Plaza, Suite 2000  
Buffalo, NY 14203-2391

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/759,536

Applicant(s)

BALBACH, CARL TEO

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. **Claims 1-4, 6-11, 15-19, 21-26, and 30-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iinuma et al. (US 6,230,325 B1).**
3. As per independent Claims 1, 16, 30, and 41, Iinuma discloses a method of selecting contact information, comprising: receiving a signal corresponding to a source document (Fig.1); analyzing the signal to determine a referenced entity identified in the source document (Fig.8); providing a data base of contact entities, the data base having information corresponding to a plurality of contact entities; determining whether the referenced entity is among the contact entities; and if the referenced entity is among the contact entities, then selecting the information corresponding to the referenced entity (C5 L14-54). (Abstract, Figs.1-2, Figs. 7-10c, C1 L49-67, C2 L1-67, C3 L1-55, C5 L2-54, C10 L56-67, Claims 1-8)
4. Iinuma fails to expressly disclose wherein the database has contact information.
5. However, Iinuma does disclose providing the user with guide information relating to the television broadcast (Abstract, 10c).

6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the database has contact information, in the system disclosed by Iinuma, for the advantage of providing a method of selecting contact information, with the ability to increase effectiveness of the system by providing the user with an array of broadcast information.
7. As per Claims 2, 17, 31, and 42, Iinuma discloses prompting a sender to provide a message to the referenced entity.
8. As per Claims 3, 18, and 32, Iinuma discloses receiving the message from the sender.
9. As per Claims 4, 19, 33, and 43, Iinuma discloses analyzing the message to determine whether the message satisfies criteria specified by the referenced entity.
10. As per Claims 6, 21, and 34, Iinuma discloses providing the message to the referenced entity.
11. As per Claims 7, 22, and 35, Iinuma discloses prompting the sender to provide a preferred method of delivering the message.
12. As per Claims 8, 23, and 36, Iinuma discloses wherein the preferred method may be provided by selecting from a group consisting of e-mail and postal address. NON
13. As per Claims 9, 24, and 37, Iinuma discloses prompting the sender to provide information required by the referenced entity.
14. As per Claims 10, 25, and 38, Iinuma discloses providing to the sender conditions that the sender must satisfy prior to sending the message.
15. As per Claims 11, 26, and 39, Iinuma discloses prompting the sender to provide information; and using the information provided by the sender to categorize the message.

16. As per Claims 15 and 40, Iinuma discloses determining a key word in the source document that is associated with the referenced entity; and prioritizing selected contact information corresponding to the referenced entity by giving a high priority to contact information associated with the key word.
17. As per Claims **44** (independent) and 46, Iinuma discloses a method of providing a sender with contact information, comprising: receiving a signal corresponding to a source document (Fig.1); analyzing the signal to determine a plurality of referenced entities identified in the source document (Fig.8); providing a data base of contact entities, the data base having information corresponding to a plurality of contact entities; determining whether the referenced entities are among the contact entities; providing a list of referenced entities [information items] that are among the contact entities [selected referenced entity]; selecting from the list of referenced entities one of the referenced entities; electing the information corresponding to the selected referenced entity (automation is inherent to the system disclosed by Iinuma); and providing the selected information to the sender (C5 L14-54). (Abstract, Figs.1-2, Figs. 7-10c, C1 L49-67, C2 L1-67, C3 L1-55, C5 L2-54, C10 L56-67, Claims 1-8)
18. Iinuma fails to expressly disclose wherein the database has contact information.
19. However, Iinuma does disclose providing the user with guide information relating to the television broadcast (Abstract, 10c).
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the database has contact information, in the system disclosed by Iinuma, for the advantage of providing a method of selecting contact

information, with the ability to increase effectiveness of the system by providing the user with an array of broadcast information.

21. As per Claims 45 and 47, Iinuma discloses providing counters, each counter being capable of providing a cumulative total, and each counter being associated with one of the referenced entities (selected contact information items); incrementing one of the counters when the associated referenced entity is selected; prioritizing the list of referenced entities by the cumulative totals provided by the counters.
- 22. Claims 5, 12-14, 20, and 27-29 are rejected under 35 U.S.C. 103 as being unpatentable over Iinuma.**
23. As per Claims 5 and 20, Iinuma does not expressly show wherein analyzing the message to determine whether the message satisfies criteria specified by the referenced entity includes determining whether the message has obscenities therein.
24. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of selecting contact information would be performed regardless of the type of message criteria used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined whether the message satisfied the criteria specified by the referenced entity, which included determining whether the message had obscenities therein, because such data does not functionally relate to the steps in the

method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

26. As per Claims 12-14 and 27-29, Iinuma does not expressly show wherein the contact information includes a postal address, Internet address, or phone number.

27. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of selecting contact information would be performed regardless of the type of contact information used.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a postal address, Internet address, or phone number as contact information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

30. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**PCT No. WO 200005679 A1 to Dichter**

Dichter discloses extracting telephone number, address, name, VRC provided for contacting advertiser, content provider, from TV program or web page displayed in PC.

31. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

“Joining Television and the Internet Using Java,” Internet Week, v2, n14, April 1, 1996.

Internet Week discloses a system, which sends a real time stream of information to be displayed during a broadcast.

32. Additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

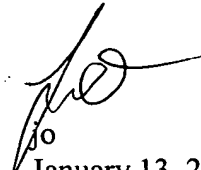
33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

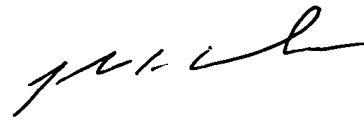


Art Unit: 3629

35. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



January 13, 2004



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600